

REMARKS

Claims 1 to 21 were pending in the application at the time of examination. Claims 1 to 21 stand rejected as obvious. Claim 10 stand objected to under 35 U.S.C. § 112, second paragraph.

Applicant(s) have amended the description to correct grammatical errors and to properly reflect the status of the U.S. Patent Application cited therein.

Claim 10 was amended as suggested by the Examiner to correct the informality. A similar amendment was made to Claim 17. Applicant requests reconsideration and withdrawal of the objection to Claim 10 under 35 U.S.C. §112, second paragraph.

Claim 16 was amended to correct an informality so that Claim 16 consistently recites "hardware information unit transfer controller."

Claims 1 to 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,477,165, hereinafter Kosco, in view of U.S. Patent No. 6,161, 155, hereinafter Sims.

Applicant respectfully notes that the MPEP directs:

**Before answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). Subject matter that is prior art under **35 U.S.C. 102** can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102."). (Emphasis Added.)**

MPEP § 2141.01, 8th Ed., Rev. 1, p. 2100-116, (Feb. 2003).

Kosco issued as a patent on November 5, 2002, which is after Applicant's filing date of April, 25, 2001. Accordingly,

Kosco was not patented before Applicant's filing date and so is not a reference under either §102(a) or §102(b). Therefore, at most, Kosco is a reference under §102(e).

However, for §102(e) art that is used in an obviousness rejection, the MPEP further states:

2146 35 U.S.C. 103(c)

35 U.S.C. 103 Conditions of patentability; non-obvious subject matter.

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(c) Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Effective November 29, 1999, 35 U.S.C. 103(c) provides that subject matter developed by another which qualifies as "prior art" only under one or more of subsections 35 U.S.C. 102(e), (f) and (g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. 35 U.S.C. 103(c) applies only to subject matter which qualifies as prior art under 35 U.S.C. 103; it does not affect subject matter which qualifies as prior art under 35 U.S.C. 102, i.e., anticipatory prior art. See MPEP § 706.02(1) - § 706.02(1)(3).

MPEP § 2146 8th Ed., Rev. 1, p. 2100-157, (Feb. 2003).

Applicant's filing date is after November 29, 1999 and so 35 U.S.C. § 103(c) applies to the instant Application. Applicant's attorney requested and received a title search of the assignment records in the U.S.P.T.O. for U.S. Patent No. 6,477,165 to verify that the information supplied by the assignee of the instant Application was supported by the assignment records. Enclosed is a true copy of the result of

the title search, which shows that Kosco was assigned to Adaptec, Inc. on July 30, 1998 and is still owned by Adaptec, Inc.

Also, enclosed is a true copy of the recorded assignment for the instant application, which was executed on April 20, 2001 and which was filed with the application on April 25, 2001. Thus, Applicant's attorney states that based upon information and belief, Kosco and the claimed invention were commonly owned by Adaptec, Inc. at the time the claimed invention was made. Therefore, under 35 U.S.C. § 103(c), Kosco "is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103."

Since Kosco was the primary reference, information relied upon by the Examiner in the secondary reference is not sufficient to establish a prima facie obviousness rejection. Applicant respectfully submits that Claims 1 to 21 are in condition for allowance. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of Claims 1 to 21.

Claims 1 to 21 remain in the application. Claims 10, 16 and 17 have been amended. For the foregoing reasons, Applicant respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 1, 2003.

  
Attorney for Applicant(s)

October 1, 2003  
Date of Signature

Respectfully submitted,



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